

REMARKS

This is a full and timely response to the non-final Office Action mailed on May 17, 2004 by the United States Patent and Trademark Office. Claims 1-46 remain pending in the application. Claims 6, 7, 20-27, and 28-46 were withdrawn in response to a restriction requirement. Claims 1 and 28 are independent claims. Claim 28 has been amended to correct a typographical error. No new matter is believed to have been added. Reconsideration is respectfully requested in light of the foregoing amendments and the following remarks.

I. REJECTIONS BASED UPON 35 U.S.C. §102

Claims 1-4, 8-12, 14-16, 18, 28-32, and 34-47 were rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent Application Pub. No. 2003/0022501 (Tsai et al.). The Examiner alleges that Tsai et al. has a U.S. Priority date of July 25, 2001 ("Tsai Filing Date"). The Applicants respectfully traverse these rejections.

Under 37 CFR 1.131 (a) "when any claim or an application...is rejected, the inventor of the subject matter of the rejected claims...may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based." In this case, the inventors of claim 1-4, 8-12, 14-16, and 18 submit a Declaration stating that the conception of the invention disclosed in at least independent claim 1 was conceived prior to the Tsai Filing Date. See Appendix. Therefore, Tsai et al. is not prior art and should be disregarded in the examination of this application. Accordingly, independent claim 1 is allowable.

However, even assuming *arguendo* that Tsai is prior art in relation to claim 1, Tsai does not recite each and every element of either claim 1 or 28. Nowhere does Tsai discuss a method for polishing a metallized surface on a workpiece, where the metallized surface has a *polish-resistant film thereon*, and the method includes the step of pretreating the metallized surface *to substantially remove said film*, as recited in claim 1. Moreover, Tsai does not suggest or mention a method for polishing a metallized layer on a workpiece, the metallized layer having a *polish-resistant film thereon*, where the method includes the step of polishing the film by creating relative motion between the film and a polishing surface at a first pressure *until the*

polish-resistant film is substantially removed, as recited in claim 28. Instead, Tsai discusses removal of conductive materials from a substrate surface. See col. 2, para. 27.

Claims 2-4, 8-12, 14-16, and 18 depend from claim 1 and claims 29-32 and 34-37 depend from claim 28. Therefore, these claims rely on the above arguments. Accordingly, reconsideration and withdrawal of these rejections is respectfully requested.

II. REJECTIONS BASED UPON 35 U.S.C. §103

Claims 5, 13, 17, and 19 were rejected under 35 U.S.C. 103 as allegedly being unpatentable over Tsai et al. Claims 5, 13, 17, and 19 all depend from independent Claim 1. Therefore, these claims rely on the arguments presented above. Accordingly, these claims should be allowed.

CONCLUSION

Based on the above, independent Claims 1 and 28 are patentable over the citations of record. The dependent claims are also submitted to be patentable for the reasons given above with respect to the independent claims and because they recite features which are patentable in their own right. Individual consideration of the dependent claims is respectfully solicited.

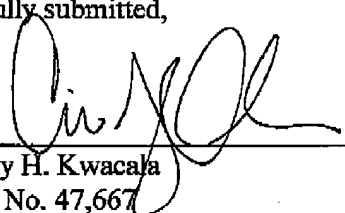
The other art of record is also not understood to disclose or suggest the inventive concept of the present invention as defined by the claims.

In view of the Applicants' amendments and remarks, it is respectfully submitted that Examiner's rejections have been overcome. Accordingly, the Applicants respectfully submit that the application, as amended, is now in condition for allowance, and such allowance is therefore earnestly requested. Should the Examiner have any questions or wish to further discuss this application, the Applicants request that the Examiner contact the Applicants' attorneys at the below-listed number.

If for some reason Applicants have not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent abandonment on this application, please consider this as a request for an extension for the required time period and/or authorization to charge Deposit Account No. 50-2091 for any fee which may be due.

Respectfully submitted,

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